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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,725	03/09/2001	Tim King	1591.0050001/RES/RDL	5084

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EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
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2181

DATE MAILED: 08/08/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,725

Applicant(s)

KING ET AL.

Examiner

Khanh Dang

Art Unit

2181

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 4 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, "said mailer" lacks clear antecedent basis. Also, the phrase, "said mailer host includes a graphical user interface that allows said recipient to forward an e-mail to said mailer using said physical address" is unclear and cannot be ascertained.

In claim 10, the phrase, "addressed to a physical address of said buyer" (lines 7 and 14) is unclear and cannot be ascertained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan.

At the outset, it is first noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure/step that differs from Hogan. With regard to claim 1, Hogan discloses a system for routing e-mails, comprising: a server (160, for example) that includes a database, the database including a mapping from a physical address to an e-mail address (in Hogan, each regular mail has a corresponding email address), wherein the server (160) is connected to a network (110, for example), the server (160) further including an electronic mailbox (email box) for each physical address (regular mail), wherein the electronic mailbox is associated with an account number and password (see at least Fig. 2a and description thereof); and a recipient host (100, for example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server (160) using the account number and the password. With regard to claims 2 and 4, it is clear that in Hogan, the recipient can print the email from the server (160) and send using regular mail. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded via regular mail. With regard to claim 3, it is clear that the server (160) provides a graphical user interface (Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to said electronic mailbox or is delivered via traditional mail. With regard to claims 5-8, one using the device of Hogan would have performed the same steps set forth in claims 1-8. With regard to claim 9, note that every mail server includes a so-called "designator" to sort emails.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Savino et al.

Savino et al. discloses a method for parcel delivery notification, comprising:
receiving an electronic order for a parcel (received purchase order information);
generating a parcel barcode representing at least a physical address of a buyer (see at least Fig. 5 and description thereof); scanning a parcel barcode (on a shipping label/packing slip); shipping the same parcel to a parcel delivery center; and
scanning the same parcel barcode at said parcel delivery center. Savino et al. does not disclose sending an email notification (email address of a buyer is contained in the barcode in addition to the buyer's physical address (see at least Fig. 5)) to a buyer when order is received and after shipment of order. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the steps of sending an email to a buyer after an on-line order is received and another email after the shipment of the order, since the Examiner takes Official Notice that sending email notification to a buyer after an on-line purchase is a common practice in e-commerce.

Application/Control Number: 09/801,725
Art Unit: 2181

Page 5

One who places an order with Amaxon.com or Dell.com, for example, will receive such notification emails.

U.S. Patent Nos. 5737729 to Denman and WO 00/68801 are cited as relevant art.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.

A handwritten signature in black ink, appearing to read 'Khanh Dang', with a stylized flourish at the end.

Khanh Dang
Primary Examiner